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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/087,066 | 03/01/2002 | Thomas Maier | AM200023-00 | 3220 |

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WASHINGTON, DC 20036

EXAMINER

RAO, DEEPAK R

| ART UNIT | PAPER NUMBER |
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1624

DATE MAILED: 12/17/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/087,066

Applicant(s)
Maier

Examiner
Deepak Rao

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1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 8, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 ☒ are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-13 ☒ are rejected.
- 7) ☒ Claim(s) 9 is/~~are~~ objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 & 6 6) ☐ Other:

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DETAILED ACTION

Claims 1-13 are pending in this application.

Election/Restriction

Applicant's election with traverse of Group I (claims 1-13 drawn to compounds of formula I wherein ~~W~~^X is CR²), in Paper No. 8 is acknowledged. The traversal is on the ground(s) that 'the claims are sufficiently structurally related to be examined in a single application'. This is not found persuasive because This is not found persuasive because as explained in the previous office action, the compounds of groups I-II are drawn to structurally dissimilar compounds (i.e., pyridines and pyrimidines) which are not art recognized equivalents. They are structurally dissimilar such that a reference anticipating a compound may not render the remaining compounds obvious. 37 CFR 1.141(a) provides that two or more independent and distinct inventions may not be claimed in one application, whether or not the misjoinder occurred in one claim or more than one claim. Restriction is going to be exercised where independent and distinct inventions are presented in one Markush grouping. Independent means when the compound is being made and/or used alone, not in combination with other compounds of the Markush expression. Restriction is considered proper in Markush claims where the members are so diverse and unrelated that a prior art reference anticipating the claim with respect to one of the members, would not render the claims obvious under 35 U.S.C. 103 with respect to the other members. Therefore, what should be considered for patentable distinctness is the compound as a

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whole. Further, the compounds of Groups I-II require separate searches in the literature and computer databases and therefore, it is **burdensome** for the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

Claim 9 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 and 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

1. In claim 1, line 9, the term “group” following ‘alkoxyalkoxy,’ is open ended. It is not clear what is intended by this term. If the ‘comma’ (,) following the term ‘alkoxyalkoxy’ is due to a typographical error, removal of the ‘comma’ would obviate the rejection.

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2. Claim 2 recites “A compound.... **and** the agronomically acceptable salts... thereof”. This is confusing because it is not clear if a compound **or** the salt, etc. is claimed or a mixture of the compound and the salt is claimed. Replacing the term “and” with -- or -- is suggested.
3. Claim 11, drawn to a composition, recites that “one compound of **general** formula I, as claimed in claim 1” (see lines 2-3). There is insufficient antecedent basis for this limitation in claim 1 on which claim 11 is dependent. First, claim 1 is drawn to ‘a method of use’ and not to ‘a compound’. Second, claim 1 does not recite “general” preceding ‘formula I’.
4. Claim 13 provides for the use of ‘a compound of general formula I’, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 U.S.C. § 101

Claim 13 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex*

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parte Dunki, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-2, 6-7 and 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Nebel et al., WO 98/21199. The instantly claimed compounds read on the reference disclosed compounds, see Example H58 and also Table 1, compounds 189, 190, 430, 431, etc.
2. Claims 2, 4, 6 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Young et al., EP 318083. The instantly claimed compounds read on the reference disclosed compounds, see Example 10 in Table 1.
3. Claims 1, 2, 3, 6 and 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Nebel et al., WO 98/21199. The instantly claimed compounds read on the reference disclosed compounds, see compounds 248, 249 in page 42.
4. Claims 2, 3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Sekiguchi et al., Chem. Abstract 115:256727. The instantly claimed compounds read on the reference

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disclosed compounds, see compounds having RN 137459-84-8 and 137459-83-7 in the enclosed copy of the CAPLUS computer search report.

5. Claims 1-2, 4-5 and 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Robson et al., WO 92/08714. The instantly claimed compounds read on the reference disclosed compounds, see the compounds in Table I wherein Z is $\text{-C}\equiv\text{C-}$, e.g., compound 1, 3, 4, etc.

6. Claims 2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ziessel et al., Chem. Abstract 134:193375. The instantly claimed compounds read on the reference disclosed compounds, see compounds having RN 327994-96-7, 327994-98-9, etc. in the enclosed copy of the CAPLUS computer search report.

7. Claims 2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Romero et al., Chem. Abstract 130:296640. The instantly claimed compounds read on the reference disclosed compounds, see compounds having RN 133810-42-1, etc. in the enclosed copy of the CAPLUS computer search report.

8. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Nakayama et al., Chem. Abstract 129:189329. The instantly claimed compounds read on the reference disclosed compounds, see compounds disclosed in the enclosed copy of the CAPLUS computer search report, e.g., RN 211937-92-7.

9. Claims 2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Nitschke et al., Chem. Abstract 128:321535. The instantly claimed compounds read on the reference

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disclosed compounds, see compounds having RN 133826-69-4 in the enclosed copy of the CAPLUS computer search report.

10. Claims 2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Chamchoumis et al., Chem. Abstract 131:82037. The instantly claimed compounds read on the reference disclosed compounds, see compounds having RN 228720-28-3, etc. in the enclosed copy of the CAPLUS computer search report.

11. Claims 2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Houghton et al., Chem. Abstract 127:256664. The instantly claimed compounds read on the reference disclosed compounds, see compounds having RN 195603-44-2, 169696-43-9, etc. in the enclosed copy of the CAPLUS computer search report.

12. Claims 2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ziessel et al., Chem. Abstract 125:221516. The instantly claimed compounds read on the reference disclosed compounds, see compounds having RN 133810-36-3, etc. in the enclosed copy of the CAPLUS computer search report.

13. Claims 2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Inouye et al., Chem. Abstract 124:146602. The instantly claimed compounds read on the reference disclosed compounds, see compounds having RN 173314-82-4 in the enclosed copy of the CAPLUS computer search report.

14. Claims 2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Koevari et al., Chem. Abstract 123:198925. The instantly claimed compounds read on the reference disclosed

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compounds, see compounds having RN 159644-78-7, etc. in the enclosed copy of the CAPLUS computer search report.

15. Claims 2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Potts et al., Chem. Abstract 118:233840. The instantly claimed compounds read on the reference disclosed compounds, see compounds having RN 147439-39-2, etc. in the enclosed copy of the CAPLUS computer search report.

16. Claims 2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Butler et al., Chem. Abstract 115:207819. The instantly claimed compounds read on the reference disclosed compounds, see compounds having RN 136413-50-8, etc. in the enclosed copy of the CAPLUS computer search report.

Note: A complete search of compounds of formula (I) wherein X is CR^2 could not be established. A representative number of the references are applied above. Applicant is requested to elect a single disclosed species in response to this action.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 2, 6, 7, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsuda et al., JP 59-152303 or JP 59-157004. The references individually teach a generic group of compounds that are structurally analogous to instantly claimed compounds.

(a) See formula (I) in page 1 of JP 59-152303 and the specific compounds 15, 41, 50, 57, 70, etc. wherein the pyridinyl has a 2-ethynyl substituent.

(b) See formula (I) in page 1 of JP 59-157004 and the specific compound 25 in page 4, col. 2 wherein the pyridinyl has a 2-ethynyl substituent.

The compounds are taught to be useful as pesticides, see the corresponding CAPLUS abstract. The instant compounds differ from the reference compounds having the -Z-A or -O-ring(W-V) group on the pyridine at a position different from the reference compounds. See for example, JP 59-152303, compound 25, the -O-Pyridinyl(substituted) is at the 5-position as compared to the instant claims wherein the substituent is at the 6-position. Therefore, the instantly claimed compounds are positional isomers of the reference compounds. It would have been obvious to one having ordinary skill in the art at the time of the invention to prepare the instantly claimed compounds because they are positional isomers of the reference compounds. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such isomeric compounds are suggestive of one another and would be expected to share similar properties and therefore, the same use as taught for the reference compounds, i.e., as pesticides. It has been held that a compound which is isomeric with a compound of prior art is *prima facie* obvious absent unexpected results. *In re Finley*, 81 USPQ

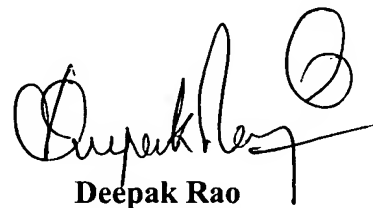
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383 (CCPA 1949); *In re Norris*, 84 USPQ 458 (CCPA 1950); *In re Dillon*, 919 F.2d at 696, 16 USPQ2d at 1904 (Fed. Cir. 1990).

Receipt is acknowledged of the Information Disclosure Statements filed on March 1 and July 25, 2002 and copies are enclosed herewith.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (703) 305-1879. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read 'Deepak Rao', with a stylized flourish at the end.

**Deepak Rao
Primary Examiner
Art Unit 1624**

December 13, 2002